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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/131,710 08/10/98 PAZ-PUJALT

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001333

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PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER NY 14650-2201

EXAMINER

GRENDZYNSKI, M

ART UNIT

PAPER NUMBER

1774

20

DATE MAILED:

10/22/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/131,710

Applicant(s)

PAZ-PUJALT ET AL.

Examiner

Michael E. Grendzynski

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Withdrawal of Finality

Due to the new grounds of rejection, below, the finality of Office Action of June 2000 is withdrawn.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Currently, the composition of the barrier layer is not enabled. The specification, on p 4 (ll 12-19), indicates a barrier layer exists, but neither discloses the composition of such a barrier layer nor discloses properties of the layer sufficient to direct one skilled in the art as to its composition.

4. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Currently, the phrase "selected so as to be able to receive" renders the claim ambiguous. The metes and bounds of the claims can not be ascertained. What are the steps of the selection process? What are the properties of such a layer? Will anything with hydrophilic properties suffice? For the purposes of examination, this (i.e., anything having hydrophilic properties) has been assumed.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by either Iqbal (US 5389723) or Hasegawa (US 4832984). Iqbal discloses a liquid absorbent article comprising (1) a support (see col. 7, ll 40-45); (2) a primer and/or subbing layer; (3) an SIPN layer and (4) an ink-permeable layer. *See* col. 7, l 59 through col. 8, l 27. The subbing and/or primer layer is equivalent to applicants' barrier layer. Once the article is printed, the SIPN is equivalent to applicants' information receiving layer containing recorded information. The ink-permeable layer is equivalent to applicants' hydrophilic layer—it is hydrophilic (comprising polyvinyl alcohol) and is capable of receiving a water-based colorant image. *See* col. 9, ll 1-5. It is inherent the SIPN layer is transparent. The limitations of the claim are met by the disclosure of the reference.

Hasegawa discloses an image forming method wherein an article comprising (1) a support; (2) an ink-retaining layer; and (3) an ink-transporting layer is imaged. *See* col. 4, ll 9-16. Once printed, the ink-retaining layer is equivalent to applicants' information receiving layer containing recorded information (it holds an image). *See* col. 3, ll 24-27. The ink-transporting layer, moreover, is equivalent to applicants' clear hydrophilic layer selected so as to be able to receive a water-based colorant image. It comprises polyvinyl pyrrolidone (*see* col. 5, ll 20-25), is transparent (*see* col. 11, ll 6-10), and is capable of receiving a water-based colorant (*see* col. 10, ll 21-25). Hasegawa further discloses that the article further comprises a reinforcing layer (e.g., a layer of SBR latex) located between the support and the ink-retaining layer. *See* col. 9, ll 8-16. This layer is equivalent to applicants' barrier layer. The limitations of the claim are met by the disclosure of the reference.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3599.

A handwritten signature in black ink, appearing to read "Bruce Hess", with a stylized flourish at the end.

BRUCE H. HESS
PRIMARY EXAMINER

Michael E. Grendzynski
Assistant Examiner
October 16, 2001